



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THORPE NORTH & WESTERN, LLP.
8180 SOUTH 700 EAST, SUITE 200
SANDY UT 84070

COPY MAILED

MAR 16 2007

OFFICE OF PETITIONS

In re Application of	:
JOHNSON et al.	:
Application No.: 10/615,569	: DECISION ON PETITION
Filed: July 7, 2003	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No.: 22027.CON	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed December 18, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

On October 28, 2005, a decision dismissing applicant's petition under 37 CFR 1.78 was mailed to applicant indicating that the amendment to the specification was not acceptable since it improperly incorporated by reference a prior-filed application.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question

whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to prior-filed nonprovisional applications have been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii) and (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted.

The original petition includes a statement of unintentional delay (although the renewed petition does not). However, applicant delayed in filing the renewed petition until over one year after the mailing of the October 28, 2005 decision even though the October 28, 2005 decision set out precisely what was required to submit a grantable petition. 37 CFR 1.78(a)(3)(iii) clearly states that "The Director may require additional information where there is a question whether the delay was unintentional."

Accordingly, before the petition under 37 CFR § 1.78 can be granted, a renewed petition under 37 CFR § 1.78 including an explanation for the lengthy delay between the mail date of the Decision of October 28, 2005 and the filing of the renewed petition on December 18, 2006 is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Daniel Stemmer at (571) 272-3301.



Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy



Boris Milef
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy